

**REMARKS**

This response is intended as a full and complete response to the non-final Office Action mailed June 17, 2005. In the Office Action, the Examiner notes that claims 1-6 are pending and rejected over certain prior art patents.

Before distinguishing Applicant's claimed invention over the cited prior art patents, Applicant will briefly summarize the claimed invention to provide a background for the following distinguishing remarks. Applicant's claimed invention is a mask, a nasal mask embodiment being shown and described, which includes, as shown in FIGS. 1-5, a shell, particularly a generally triangular hollow shell 12, including an outwardly extending gas inlet conduit 22 and which shell has a perimeter 20 to which the seal 14 is mounted. Such mask further includes an elastic headband 16 provided with an opening 24, note particularly FIG. 4, through which the conduit 22 extends to mount the headband to the shell and, in turn, the headband is for being stretched radially outwardly to surround the person's head as shown in FIG. 5 and to removably mount the mask to a person's face for the receipt of breathable gas.

Claims 1, 2, 4 and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over Correa (U.S. Patent No. 6,119,694) in view of Shaffer (U.S. Patent No. 4,326,515). Applicant respectfully traverses the Examiner's position that Correa discloses in FIGS. 1 and 4-7 the claimed invention with the exception of the one-piece elastic headband. To the contrary, Correa does not disclose a mask including a shell provided with a perimeter and including an outwardly extending gas inlet, note particularly FIG. 4 of Correa which clearly shows an assembly including a nare seal 14 mounted by screws to support arms 16 and 18—no mask shell, particularly a generally triangular hollow shell, is shown or even suggested in Correa. Correa's nare seal 14 sealingly engages above a person's upper lip and below a person's nose, or nares, and is held in place by the non-elastic arms 26 and 32 and 28 and 34, note Correa FIG. 2. The Examiner acknowledges that Correa does not disclose a one-piece elastic headband. This deficiency is not filled-in by Shaffer who merely discloses an elastic band 18 for mounting an endotracheal tube 12 to a block 14 mounted

indirectly to a head strap 16 which utilizes hook and loop members 26 and 24 to mount the retainer 10 to a patient as illustrated, for example, in FIGS. 3 and 4. Shaffer neither discloses nor describes a mask, particularly a nasal mask, and neither teaches nor suggests the use of an elastic headband for mounting a nasal mask to a person's face. With regard to the Examiner's statement that Shaffer teaches that it is known to utilize an elastic headband to mount and hold a tube connected within a patient, it is submitted that while this may be true it is not relevant to Applicant's claimed invention. Applicant's claimed headband does not mount and hold a tube connected within a patient. Further, Applicant's elastic headband does not mount the gas inlet tube provided on, and part of, Applicant's shell 12. Applicant's gas inlet conduit 22 is a part of Applicant's shell 12 (note particularly FIG. 3), and Applicant's elastic headband 16 does nothing to mount Applicant's gas inlet 22 to Applicant's shell 12. Applicant's conduit 22 extends through the opening 24 provided in Applicant's elastic headband 16 to mount the headband to the shell as expressly recited in independent claim 1 and which headband, as further expressly recited in independent claim 4, is stretched radially outwardly to surround the person's head and to removably mount the nasal mask to the person for the receipt of breathable gas.

Accordingly, the elements expressly recited in Applicant's claims 1, 2, 4 and 6 are not shown in either Correa or Shaffer when taken alone or in combination. Accordingly it is submitted that Applicant's claimed invention as defined by these claims would not be obvious to one of ordinary skill in the mask art due to the differences between the elements recited in Applicant's claim and the elements shown and described in Correa and Shaffer. Thus, it is submitted that these claims are not obvious under 35 U.S.C. §103(a) in view of Correa and further in view of Shaffer.

Referring to the rejection of dependent claims 3 and 5 as being obvious and unpatentable over Correa in view of Shaffer and further in view of Haber (U.S. Patent No. 4,790,307), this rejection is further respectfully traversed. First Applicant submits that dependent claims 3 and 5, which depend respectively on claims 2 and 4, are allowable for the same reasons set forth above showing the

patentability of claims 1, 2, 4 and 6. Secondly, Haber merely discloses a disposable surgical mask including a bottom layer 2 to which a top layer 4 is attached and which layers are provided with ear holes 10. Haber neither teaches nor suggests a mask, particularly a nasal mask, including a shell, particularly a generally triangular hollow shell, a seal mounted to the periphery of the shell, and an elastic band provided with an opening through which an outwardly extending gas inlet conduit provided on the shell extends to mount the headband to the shell as defined by dependent claims 3 and 5 due to their dependency, directly and indirectly, on claims 1, 2, 4 and 6. For these reasons, it is respectfully submitted that one of ordinary level of skill in this art would not find the differences between Applicant's claimed invention in claims 3 and 5 and the elements disclosed in these three prior art patents to be obvious.

Furthermore, it is respectfully submitted that the combination of Correa and Shaffer and Correa, Shaffer and Haber as a basis for rejecting Applicant's claims is an impermissible hindsight rejection.

For prior art reference to be combined to render obvious a subsequent invention under 35 U.S.C. §103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. Uniroyal v. Rudkin-Wiley, 5 USPQ 2d 1434, 1438 (Fed. Cir. 1988). The teachings of the references can be combined only if there is some suggestion or incentive in the prior art to do so. In re Fine, 5 USPQ 2d 1596, 1599 (Fed. Cir. 1988). Hindsight is strictly forbidden. It is impermissible to use the claims as a framework to pick and choose among individual references to recreate the claimed invention Id. at 1600; W.L. Gore Associates, Inc., v. Garlock, Inc., 220 USPQ 303, 312 (Fed. Cir. 1983). Correa neither teaches nor suggests the desirability or obviousness of substituting an elastic band for the non-elastic bands 26 and 32 and 28 and 34. Similarly, Shaffer includes no suggestion or incentive for providing his elastic band 18, which mounts an endotracheal tube 12 to a block 14, with an opening to which a conduit provided on a mask shell extends to mount an elastic headband to a mask shell. Simply put, Shaffer is not concerned in any manner with the mounting of an elastic

headband to a mask shell. Further, Haber neither teaches nor suggests a mask including a shell and neither teaches nor suggests that his layers 2 and 4 provided with the ear holes 10 can be provided with an opening to mount an elastic band to a mask shell. Thus, it is further respectfully submitted that it is impermissible to use Applicant's claims as a framework to pick and choose among these three individual references to recreate the claimed invention.

### **CONCLUSION**

Thus, Applicant submits that claims 1-6 are allowable over Correa, Shaffer and Haber. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited. If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone R. Gale Rhodes, Jr. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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